

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicants: Toshiaki KATSUMA et al.

Serial No.: 10/801,826

Art Unit: 2627

Filed: March 17, 2004

Examiner: ORTIZ CRIADO, Jorge L.

For: APERTURE LIMITING ELEMENT AND OPTICAL PICKUP DEVICE
UTILIZING IT

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 22, 2008

Sir:

Responsive to the Final Office Action dated November 29, 2007, please extend the period for response by three months and consider the below Remarks.

REMARKS

Claims 1 - 32 are pending, with claims 3, 5 - 15, 18, 20, 21, and 23 - 32 having been withdrawn from consideration as being drawn to non-elected Species.

Claims 1, 2, 4, 16, 17 and 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by JP Publication No. 09-054977 (hereinafter referred to as Katayama). The Examiner has improperly categorized item 23 of Katayama as being a “substrate”, which it **clearly** is **not**. The machine translation supplied by the Japanese Patent Office web server lists item 23 of Katayama as being a “phase compensation film”. Moreover, it lists item 22 of Katayama as being a “wavelength filter film” and item 21 of Katayama as being a “glass substrate”. Because the glass substrate 21 of Katayama does not include “. . . an aperture that is an open space of a specified size formed in a substrate . . .” as recited in line 2 of claim 1, claim 1 is clearly not anticipated by Katayama. Furthermore, the aperture limiting element of Katayama is **incapable** of performing the function of the present invention as set forth at page 4, lines 2 - 7, of Applicants’ specification as filed, namely: “. . . the aperture limiting element of the present invention greatly reduces the amount of light that is reflected at the surface of the aperture limiting element and is then returned to the laser light source, thereby causing unwanted instability in the laser light source, while enabling the recent demand for thickness reduction of optical pickup devices to be met even when the aperture limiting element is placed on the optical axis of the optical pickup device.” The glass substrate 21 of Katayama, when placed on the optical axis of an optical pickup device, would inherently reflect light (since there is no aperture that is an open space in the substrate), and the reflected light would cause unwanted instability in the laser light source. Because each of claims 2, 4, 16, 17 and 19 are dependent claims that, directly or indirectly, depend from claim 1, none of claims 2, 4, 16, 17 or 19 is anticipated by Katayama for the reason that these claims include the limitation in line 2 of claim 1 that is quoted above. Therefore, it is respectfully requested that the rejection be carefully reconsidered and withdrawn. Note also that, at best, the phase compensation film 23 of Katayama is a ‘superstratum’, not ‘a substrate’.

Claim 22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP Publication No. 09-054977 (i.e., Katayama) in view of Kadowaki et al. (US-2001/0036142).

Reconsideration of this rejection is respectfully requested. Claim 22 depends from claim 16, which in turn depends from claim 1. Thus, claim 22 includes all the limitations of claim 1. Moreover, Kadowaki et al. in no way makes up for the deficiency of claim 1 **not** being anticipated by Katayama, as discussed in the previous paragraph. Thus, the rejection of claim 22 under 36 U.S.C. 103(a) is **clearly improper** and should be withdrawn on the basis that Katayama in view of Kadowaki et al. does not suggest the feature “. . . an aperture that is an open space of a specified size formed in a substrate . . .” as recited in line 2 of claim 1.

Having pointed out that the rejections of record are improper and should be withdrawn, it is respectfully submitted that, unless more pertinent prior art is found that makes claim 1 unpatentable, an early Notice of Allowability should be provided. Moreover, it is respectfully submitted that **certain additional claims**, as will now be discussed, should be rejoined and examined. The Requirement for Election of Species as contained in the Office Communication dated 02/07/2007 did not make any statement regarding there being no **linking** claim or claims. All that was stated was “. . . this Application contains claims drawn to a plurality of species with no **generic** claims.” (emphasis added). Although the undersigned did not traverse the Election of Species requirement, the third paragraph of the Remarks in the Preliminary Amendment and Election filed April 2, 2007 noted that “. . . claim 1 is a linking claim that links claim 5 as amended above . . .”. The basis for this assertion was that claim 5 was amended in the Preliminary Amendment to include all the limitations of claim 1. In preparing the prior Office Communication dated 02/07/2007, the Examiner did not comply with M.P.E.P. §809.03, which states: “Examiners should use form paragraph 8.12 to make restrictions involving linking claims when the linking claim is other than a genus claim linking species inventions”. Nevertheless, the Examiner is required to follow the examination procedure discussed in form paragraph 8.12, which states: “Upon the indication of allowability of the linking claim(s) . . . any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be . . . fully examined for patentability in accordance with 37 CFR 1.104”. Thus, **in the event claim 1 is found allowable, the Examiner is required to rejoin any claim that includes all the limitations of claim 1 and to fully examine the rejoined claims for patentability in accordance with 37 C.F.R. §1.104.** Therefore, unless more pertinent prior art is found that makes claim 1 unpatentable, it is respectfully submitted that:

(a) claim 1, as well as claims 2, 4, 16, 17, 19 and 22 that include all the limitations of claim 1 by reason of their dependency, should be allowed;

(b) claims 3, 9 - 13, 15 and 18 that, directly or indirectly, depend from claim 1 (and thus include all the limitations of claim 1) must be rejoined and examined;

(c) amended claim 5 (that is linked by linking claim 1, since amended claim 5 includes all the limitations of claim 1) must be rejoined and examined; and

(d) claims 7, 20, 23, 25 and 30 that, directly or indirectly, depend from claim 5 (and thus include all the limitations of claim 5) must be rejoined and examined, since claim 5 includes all the limitations of claim 1.

Therefore, unless more pertinent prior art is found, an early Notice of Allowability, which indicates that:

(a) claims 3, 5, 7, 9 - 13, 15, 18, 20, 23, 25 and 30 have been rejoined, and

(b) claims 1 - 5, 7, 9 - 13, 15 - 20, 22, 23, 25 and 30 have been found allowable,
is earnestly solicited.

Please charge the fee (\$1,050.00) for a three month extension of time to the undersigned's Deposit Account No. 01-2509. In addition, if any additional fees are required, please charge them, or credit any overpayments, to Deposit Account No. 01-2509.

Respectfully submitted,

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